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To: Office of Petitions
Box DAC
Assistant Commissioner for Patents
Washington, DC 200231

**PETITION TO ACCEPT AN UNINTENTIONALLY DELAYED CLAIM FOR
PRIORITY UNDER 35 USC 119(e)
and
PETITION TO WAIVE SURCHARGE ASSOCIATED THEREWITH as per 37
CFR 1.182**

By: Leonard Duffy, Applicant, pro se
**Fee is enclosed in the amount of \$130 as per 37 CFR 1.17 (h) for petition under
section 1.182**

SUMMARY:

In a First Office Action dated 24 April 2003 (page 3) by examiner James R. Brittain, applicant was notified that applicant's request for priority status based upon two previously filed provisional patent applications was improperly stated because it was not in the form of a sentence. Applicant, acting pro se, was unaware of the requirement for a "sentence" format, but did include the reference in a non-sentence format in the proper location. Therefore applicant petitions for waiver of the unintentional informality and delay and also requests relief from the surcharge under 37CFR1.17(t) and 3, on the grounds that such surcharge is unreasonable and onerous in relation to the scope of the unintended offense.

PETITION FOR WAIVER REGARDING PRIORITY:

Applicant requests a waiver as provided under 37 CFR 1.78 (a)(6) based upon the following:

1. In accordance with 35 USC 119 (e)(1), the applicant filed an application under 35 USC 11(a) "... not later than 12 months after the date on which a provisional application was filed..." containing "...a specific reference to the provisional application(s)."
2. Applicant requested priority status by including the following paragraph on the first page of the application, after the title and immediately before the beginning paragraph of the specification entitled "Field of Invention":

"Ref Provisional patent applications
60/228, 780 05/05/2001
60/241,707 10/19/2000"

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(Applicant mistakenly also included the Abstract on the same page before the above referenced paragraph instead of on a separate page as required ((now corrected)). A typographical error regarding one of the reference numbers ((60/228,780 should be 60/288,780)) was noted by the examiner and has also been corrected in the applicant response to the Office Action). However, the intent to reference the priority claim as a separate paragraph at the beginning of the application is clear.

3. Applicant clearly intended said paragraph to convey his desire for a claim of priority based upon the referenced provisional applications, because:
 - a. There would be no other reason for including said paragraph at such a location in the application.
 - b. The referenced Provisional Applications are clearly related and pertinent to the present application and disclose substantially the same invention as the present application.
 - c. The applicant's intent was understood and interpreted by the examiner as a request for priority as stated on page 5, paragraph 2 of the recent Office Action.
4. Applicant was acting pro se without the benefit of legal guidance and was unfamiliar with the specific requirement of 37 CFR 1.78 (a)(5)(iii) for a "sentence" format. Also, the "Publication" rules were relatively new at the time of application and were not fully understood by the applicant.
5. The present application was filed on 10/19/2001. A Confirmation of receipt (no.9503) was sent on 02/07/2002 along with a "Notice to File Corrected Application Papers" regarding format of the claims. However:
 - a. No notice was provided regarding the priority claim informality until the Office Action of 04/24/2003. Also, no notice was provided regarding the location of the Abstract within the text.
 - b. Previous correspondence with the examiner (December 2002/January 2003) regarding Division of the application made no note of the priority issue.
 - c. The "Confirmation" receipt includes the statement "**Domestic Priority data as claimed by applicant**" which was interpreted by the applicant at the time of receipt as recognition of his priority claim. Although in retrospect, it appears that such statement is intended only as a title; because there is not a colon after the line of text, its meaning is ambiguous to a person not familiar with the form.
 - d. The application was filed at the time of the unfortunate anthrax mail incident in the Washington DC area, perhaps causing delays or undue haste in logging-in applications at the PTO.
 - e. Had the informality been brought to the applicants attention by the PTO at the time of initial receipt, remedy could have been provided in a timely manner.

6. The subject informality in format was unintentional, and the entire delay between the date the claim was due under 37 CFR paragraph (a)(5)(e) and the date the corrected claim has now been filed was unintentional.
7. A corrected priority claim has been filed in the Response to Office Action as follows:
 - a. "This Application claims the benefit of US Provisional Applications No.60/288,780 filed 05/05/2001 and No. 60/241,707 filed 10/19/2000 in regard to Priority status as provided under 35 USC 119 (e)(1)."

PETITION FOR WAIVER OR REDUCTION OF SURCHARGE:

Applicant requests waiver or reduction of the surcharge specified in 37 CFR 1.17 (t) for the following reasons:

1. Based upon the forgoing, the mistake in format and related delay was clearly unintentional.
2. The applicant, acting pro se at a time when significant changes were being instituted by the PTO regarding publication rules, was unaware of the specific format requirements but clearly intended to cite a proper claim for priority.
3. The PTO did not notify the applicant of his mistake in time to make a timely correction without incurring a surcharge.
4. The extent of the offense is clearly minor in relation to the surcharge imposed.
5. The magnitude of the \$1300 surcharge (37 CFR 1.17 (t)) is onerous to this small entity applicant. It appears to be excessive in relation even to the initial application fee, and no provision appears to be allowed for small entity status.
6. A fee of \$130 is included with this petition as per 37 CFR 1.182.

Respectfully submitted,



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